

Remarks

This Application has been carefully reviewed in light of the final Office Action mailed December 30, 2003. Applicant believes all pending claims are allowable over the prior art of record. Applicant has amended Claims 12 and 36. These amendments have not narrowed the claims and are not considered necessary for patentability. Applicant respectfully requests reconsideration and allowance of all pending claims.

Claims 12 and 36 Recite Patentable Subject Matter

The Examiner rejects Claims 12 and 36 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Although Applicant believes all claims are directed to patentable subject matter without amendment, Applicant has amended Claims 12 and 36 to further clarify that these claims recite computer-implemented methods performed using a computer system and are directed to patentable subject matter. These amendments are not considered narrowing and are not considered necessary for patentability. For at least these reasons, Applicants respectfully request reconsideration and allowance of Claims 12 and 36.

Claims 1-37 are Allowable Under 35 U.S.C. § 112, Second Paragraph

The Examiner rejects Claims 1-37 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

"The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with the information known in the art without undue experimentation." M.P.E.P. § 2164.01 citing *United States v. Teletronics, Inc.*, 857 F.2d 778, 785 (Fed. Cir. 1988). There is no requirement that the specification provide concrete examples or illustrations of claimed steps. In fact, "[c]ompliance with the enablement requirement of 35 U.S.C. 112, first paragraph, does not turn on whether an example is disclosed." M.P.E.P. § 2164.02. All that is required is that the "information contained in the disclosure of an application must be sufficient to inform those skilled in the relevant art how to both make and use the claimed invention. *Detailed procedures for making and using the invention may not be necessary if the description is sufficient to permit those skilled in the art to make and use the invention.*" M.P.E.P. § 2164. Applicant

respectfully submits that the Specification provides sufficient information and detail to enable those skilled in the art at the time of invention to make and use the claimed invention. Applicant addresses the Examiner's particular objections below. In addressing each of the Examiner's particular objections, Applicant refers to example discussions within the Specification; however, reference to these portions should not be used to limit Applicant's claims.¹

The Examiner states that as to Claims 1, 12, 23, and 34-37, Applicant "fails to disclose the transition mechanism to transform a single product classification schema as stated in the preamble of these claims into the set of first schema and second schema as cited in the body of these claims, in addition, applicant did not define the metes and bounds of the claimed first schema and second schema." (Office Action, Page 4)

First, Applicant notes that the term "transition mechanism" is not used anywhere in Claims 1, 12, 23, and 34-37. Rather, as the preambles and bodies of these claims make clear, these claims recite "associating target data with a product classification schema." Nor do these claims recite "*transform[ing] a single product classification schema . . . into the* set of first schema and *second schema*" as the Examiner suggests. (See Office Action, Page 4) Instead, these claims recite "determining one or more classes of the first schema with which at least a portion of the target data should be associated based on an automatic comparison, *without translating* the target data from the second schema to the first schema, between the target data and the product attributes of the ontologies of the first schema or between the target data and values for one or more of the product attributes of the ontologies of the first schema," and "associating the at least a portion of the target data with one or more classes of the first schema in response to determining, based on the automatic comparison, the one or more classes of the first schema with which the at least a portion of the target data should be associated" accordingly.

Second, apart from the mischaracterizations of Applicant's claim language, Applicant respectfully disagrees with the Examiner's statement that there is no disclosure of the "transition mechanism." For example, the *data association module* recited in the preamble

¹ See *Superguide Corp. v. DirecTV Enters., Inc.*, 2004 WL 253013, at *3 (Fed. Cir. 2004) (stating that the specification of a patent cannot be used to import limitations into a claim that are not recited in the claim to narrow or otherwise change the ordinary meaning of a claim term).

of Claim 1 is described in sufficient detail in the body of Claim 1 itself to enable those of ordinary skill in the art at the time of invention to make and use the claimed invention. In addition, Applicant respectfully directs the Examiner's attention to the Specification at Page 9, lines 1-6; Page 20, line 20 through Page 21, line 25; and Page 21, line 26 through Page 28, line 25, describing example operation of the data association module.

Third, it is not entirely clear what the Examiner means by "the metes and bounds of the claimed first schema and second schema." Claims 1, 12, 23, and 34-37 each clearly recite that the first product classification schema may be any product classification "comprising a taxonomy comprising a hierarchy of classes into which products may be categorized, the first schema further comprising ontologies associated with one or more of the classes, each ontology comprising one or more product attributes," and that the second product classification schema may be any product classification schema. In addition, example descriptions of the first product classification schema and the second product classification schema appear at least at the above-cited portions of the Specification, as well as at Page 9, line 1 through Page 10, line 25. Applicant emphasizes that these are merely example schemas.

Fourth, the Examiner states that Applicant "also fails to disclose what mechanism was used to organize the claimed target data according to a second product classification schema." (Office Action, Page 4) In addition, Applicant respectfully directs the Examiner's attention to the Specification at Page 20, line 20 through Page 21, line 25, at which Applicant describes, as an example second product classification schema, product and/or seller data in a seller database that is to be associated with GCD 42 based on the ontology used in a particular schema of GCD 42. This portion of the Specification certainly discloses the limitations to which the Examiner refers in sufficient detail to enable those of ordinary skill in the art at the time of invention to make and use the claimed invention.

For at least these reasons, Applicant respectfully submits that Applicant's Specification complies with 35 U.S.C. § 112, first paragraph. Thus, Applicant respectfully requests reconsideration and allowance of independent Claims 1, 12, 23, and 34-37, and their respective dependent claims.

Claims 1, 12, 23, and 34 are Allowable over *Chipman*

The Examiner rejects Claims 1, 12, 23, and 34 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 6,038,668 to Chipman et al. ("*Chipman*"). Applicant respectfully disagrees.

At the outset, Applicant addresses the Examiner's statements that "[b]ecause of the enable issue of the amended claims, and per applicant's citation that 'Applicant has made clarifying amendments to Claims 1-37. Certain of these amendments have not narrowed the claims and none are considered necessary for patentability' as such, the examiner regards that applicant has no intention to use instant amendment for applying a patent of his invention. Thus, based on the direction from applicant, the examiner maintains the same art rejection as filed in the previous office action" (Office Action, Page 5) (citations omitted; emphasis in original)

First, Applicant respectfully submits that Claims 1-37 are clearly enabled by the Specification, as discussed above.

Second, Applicant respectfully submits that the Examiner is required to give proper patentable weight to all the limitations recited in Applicant's claims. Applicant's statement that "none [of the amendments] are considered necessary for patentability" is merely an assertion by Applicant that, in Applicant's opinion, the claims were allowable over the cited references without amendment. Applicant is fully entitled, and is in fact encouraged by the Federal Circuit case law, to state this opinion on the record to rebut any presumption that Applicant acquiesces to the Examiner's rejections or that the amendments were necessary for patentability. However, despite Applicant's disclaimer, Applicant ***did amend*** certain claims in the previous Response and the Examiner apparently ***did enter*** these amendments (see Office Action, page 2) Furthermore, Applicant discussed these amendments in responding to the previous Office Action. Thus, the Examiner must consider these amendments.

Third, because the Examiner did not consider Applicant's amendments when applying *Chipman* to Applicant's claims, Applicant respectfully submits that the Examiner prematurely issued a final Office Action. According to 37 C.F.R. § 1.112, after a reply by Applicant to a

non-final office action, the application will be reconsidered and again examined. By not considering Applicant's amendments presented in the previous Response, the Examiner did not reconsider and again examine the Application, including the amendments to Applicant's claims, as required under 37 C.F.R. § 1.112. Instead, the Examiner merely reiterates the anticipation rejection presented in the first Office Action without considering the amendments. However, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987); M.P.E.P. § 2131. The inadequacy of the Examiner's "examination" of the Application in light of Applicant's previous Response (including consideration of the amendments) is apparent in the fact that the Examiner does not demonstrate, and does not even assert, that *Chipman* discloses the amended portions of Applicant's claims. Thus, for the Examiner to properly make the current Office Action final, the Examiner was required to have at least examined the Application in light of Applicant's previous Response (including consideration of the amendments). For at least these reasons, Applicant respectfully requests that the Examiner withdraw the finality of the current Office Action and consider Applicant's amendments before issuing any subsequent Office Action or, more appropriately, a Notice of Allowance.

Applicant reiterates below the arguments substantially as presented in the previous Response with respect to the allowability of Claims 1-37, as amended in the previous Response, over *Chipman*.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987); M.P.E.P. § 2131. In addition, "[t]he elements must be arranged as required by the claim." *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 U.S.P.Q.2d

1566 (Fed. Cir. 1990); M.P.E.P. § 2131 (emphasis added). *Chipman* fails to disclose, teach, or suggest at least the following limitations recited in Claim 1²:

- determine one or more classes of the first schema with which at least a portion of the target data should be associated ***based on an automatic comparison***, without translating the target data from the second schema to the first schema, between the target data and the product attributes of the ontologies of the first schema or between the target data and values for one or more of the product attributes of the ontologies of the first schema; and
- associate the at least a portion of the target data with one or more classes of the first schema ***in response to determining, based on the automatic comparison***, the one or more classes of the first schema with which the at least a portion of the target data should be associated.

In contrast, *Chipman* discloses a networked catalog search, retrieval, and information correlation and matching system, which allows suppliers to publish information in electronic catalogs and structure the information in an object-oriented representation distributed across a network of computers. (Abstract) According to *Chipman*, a scanning engine scans computers having accessible pages to locate all pages having ***the predefined organizational structure*** as including class, attribute, and methods information. (Column 3, Lines 27-30) To enable each information supplier to provide requisite information on its pages, a "sector" portal establishes common terms (class, attribute, and method names) for the suppliers and consumers to use. (Column 4, Lines 9-12) ***Thus, with Chipman, an information supplier must use common, predefined terms in order to supply information to the portal.*** *Chipman* further states, "The sector portal is so named because each industry sector is contemplated to have at least one governing portal from which all other portals in that industry sector derive their common vocabulary, taxonomy, or ontology." (Column 4, Lines 12-16)

To provide information to portal 102, suppliers 104 and 105 encode their pages using a predefined protocol. Use of the protocol encourages placing available information in an

² Support for Applicant's clarifying amendments and arguments can be found at least at page 21, lines 7-25 and throughout the description of FIGURE 6 located at page 21, line 26 through page 28, line 25 of the

organized format. The protocol may include tag codes, which describe the information contained therein. (Column 6, Lines 7-12) A tag (e.g., <UC*>, where "*" may include additional tags) is the identifier to the portal that a page is in an organizational format usable by the portal. (Column 6, Lines 27-29) A web crawler associated with the portal periodically scans the web for pages and parses the pages. (Column 7, Lines 17-19) The parsed pages containing a usable organization structure (e.g., identified as including the <UC*> tags) are stored in a knowledge base for indexing and future retrieval. (Column 7, Lines 20-23) A portal as disclosed in *Chipman* also includes a protocol translator that facilitates supplier publication of HTML pages that are compliant with the protocol and the industry common vocabulary or ontology. (Column 8, Lines 42-45)

According to *Chipman*, the supplier of information may be a high-end supplier or a low-end supplier, each type submitting information to the portal in a different way. In the case of a low end supplier (who lacks the capability or desire to support organized pages locally), pages 307 are retrieved from the portal, pages 307 including at least one template for populating and submitting back onto web 101. (Column 8, Lines 51-57) Template pages 307 include at least one initial set of class, attribute, and method identifiers for population. (Column 8, Lines 58-60) ***Thus, with Chipman, the supplier posts information by simply filling out a predefined template that identifies what supplier information corresponds to each of the class, attribute, and method entries.***

In the example provided in *Chipman*, a supplier may request from the portal the design template for electric motors, and in reply, the protocol translator may retrieve the desired class/subclass, attribute, and method ontologies. The ontologies are translated into an HTML form and sent to the supplier's Internet browser as template pages, which the supplier then populates (with supplier information) as completed pages. The completed pages are forwarded back to the portal where the pages are parsed and added to the knowledge base. (See, Column 8, Line 60 through Column 9, Line 3) ***Thus, with Chipman, the parser of the portal knows exactly what information corresponds to class, attribute, and method, respectively, because the supplier of the information merely filled in a template.***

Specification. Thus, these clarifying amendments do not constitute new matter.

Alternatively, a high-end supplier according to *Chipman* has the capability to publish its own protocol-compliant pages. (Column 10, Lines 21-22) ***However, with Chipman, the high-end supplier is still simply filling in a predefined template.*** According to *Chipman*, a supplier requests a template page, which may be transferred to the protocol translator where the template page is combined with data (class, method, attribute, etc.) specifying the supplied products and processes from the supplier. (Column 10, Lines 26-30)

Thus, at best, *Chipman* allows an information supplier to submit information in a predefined template (i.e. tagged in a particular, predefined way) to be published and searched. The only mapping between the supplier's information and the predefined ontologies at the portal that occurs is when the supplier manually looks at the template to determine what information should be tagged "class," what information should be tagged "attribute," and what information should be tagged "method."

In contrast to Applicant's recited data association module, *Chipman* requires human action to determine what supplier information should be input into the template as each of class, attribute, and method. Furthermore, *Chipman* fails to disclose, teach, or suggest a data association module operable to "determine one or more classes of the first schema with which at least a portion of the target data should be associated ***based on an automatic comparison, without translating the target data from the second schema to the first schema***, between the target data and the product attributes of the ontologies of the first schema or between the target data and values for one or more of the product attributes of the ontologies of the first schema." There simply is no such "comparison" disclosed in *Chipman*, much less the "automatic comparison" recited in Claim 1, because the system in *Chipman* does not need such a comparison. A supplier in *Chipman* merely fills out a predefined template, which specifies what information is a class, what information is an attribute, and what information is a method, to make the supplier's information available to the portal (and to other users via the web). The system of *Chipman* does not need to look at what information the supplier is actually submitting, because the supplier has labeled the submitted information by placing it in a particular portion of the template.

The Examiner compares a Tool Suite disclosed in *Chipman* to certain limitations recited in Claim 1. (Office Action, Page 5) However, Applicant respectfully submits that the tools discussed in the cited portion of *Chipman* are unrelated to these limitations. Certain users of the system disclosed in *Chipman* may search supplier provided information to for components to be included in end products. These tools are available to these users. For example, the tools may include a requirements integration and verification tool, which assures that assembled design objects (end items) meet individual requirements and comply with predefined rules. (Column 13, Lines 43-46) As another example, the tools may include an affordability monitor, which determines if the cost of the included items and the processes required for a combination of items exceeds predetermined budgets. (Column 13, Lines 46-48). However, nowhere do these tools "determine one or more classes of the first schema with which at least a portion of the target data should be associated ***based on an automatic comparison, without translating the target data from the second schema to the first schema***, between the target data and the product attributes of the ontologies of the first schema or between the target data and values for one or more of the product attributes of the ontologies of the first schema," as recited in Claim 1 as amended.

Because *Chipman* fails to disclose, teach, or suggest the recited "an automatic comparison" or even a "comparison," *Chipman* necessarily fails to disclose, teach, or suggest a data association module operable to "associate the at least a portion of the target data with one or more classes of the first schema ***in response to determining, based on the automatic comparison***, the one or more classes of the first schema with which the at least a portion of the target data should be associated," as recited in Claim 1 as amended.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of independent Claim 1 and its dependent claims. For substantially similar reasons to those discussed with reference to independent Claim 1, Applicant respectfully requests reconsideration and allowance of independent Claims 12, 23, and 34-37 and their respective dependent claims.

Conclusion

Applicant has made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicant respectfully requests full allowance of all pending claims.

If the Examiner believes a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Christopher W. Kennerly, Attorney for Applicant, at the Examiner's convenience at (214) 953-6812.

Applicant believes no fees are due; however, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,
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